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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/160,991	09/25/1998	TZYH-CHYANG CHERNG		6990

7590 07/16/2002

WOOD HERRON & EVANS
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CINCINNATI, OH 45202

EXAMINER

PAYER, HWEI SIU CHOU

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/160,991

Applicant(s)

CHERNG ET AL.

Examiner

Hwei-Siu C. Payer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 24-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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Detailed Action

Applicants' response filed on June 7, 2002 has been received.

Claims Rejection – 35 U.S.C. 103(a)

1. Claims 1-7, 10, 12-14, 16-22, 24, 27 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (U.S. Patent No. 3,952,179) in view of Maybon (U.S. Patent No. 5,580,472) for the same reasons set forth in the last Office action (mailed on March 7, 2002).
2. Claims 8, 9, 11, 15, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (U.S. Patent No. 3,952,179) and Maybon (U.S. Patent No. 5,580,472) as applied to claims 1, 10, 13 and 22 above, and further in view of Cox et al. (U.S. Patent No. 5,417,132) for the same reasons set forth in the last Office action (mailed on March 7, 2002).

Remarks

Applicants argue, at pages 3-4 of the response, that Maybon '472 shows resurfacing the tops of the ridges on a refining plate and does not teach ridge or blade forming on a body surface from different material than the body.

Applicants' attention is directed to the primary reference (Baker '179) which clearly shows die blades formed on a die body from different material than the die body as claimed.

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The sole difference between Baker '179 and the claimed invention resides in the heat source used for cladding. Specifically, Baker uses welding rather than a laser for cladding the hard blade material onto the less harder die body.

However, cladding a harder material onto a less ^{harder} material by use of laser as a heat source is well known in the art as evidenced by the Maybon reference.

In short, the main concept of cladding a harder material onto a softer base material to form a blade on the base material in order to increase the useful life of the cutting tool while reducing the cost of the cutting tool is clearly shown in the primary reference to Baker '179. Maybon '472 is merely used as a teaching reference to show that it is well known in the art to clad a harder material onto a softer material by use of laser as a heat source.

Applicants further argues, at page 5 of the response, that Baker patent is directed to cutting dies, whereas the Maybon patent is directed to paper pulp defibering and refining plates. The patents are non-analogous.

In response, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we must decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 202 USPQ 171, 174.

In this case, **both Baker and Maybon references are relating to cladding a harder material onto a less harder body** to form a working tip. It is clearly pertinent to the particular problem with which the inventors were involved.

The affidavit of Paul S. Madill under 37 C.F.R. 1.132 is given very little probative value for the following reasons:

(1) Mr. Madill has not established there was a commercial success because he did not give competitive figures for sales for the entire market.

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(2) Mr. Madill has failed to establish the nexus between the commercial success and the inventive features because he does not carry his burden under the standard setup in In re Caveney. In In re Caveney, the Court, in an opinion by Judge Rich, held that a nexus vis-a-vis the commercial success of the wiring duct there at issue was not adequately demonstrated where four out of five proclaimed advantages of the invention were also presented in the prior art devices. The Court decided that the commercial success may well be due to those features (the features found in the prior art). 386 F.2d 917, 922-23, 155 USPQ 681 (CCPA 1967). All three advantages (laminated structure, relatively ^{small} size, and apertured configuration) Applicant is relied on are shown in the prior art devices (Calavetta and Domo).

(3) Mr. Madill has not shown under the standard set forth in In re Heldt (433 F. 2d 808, 812-13, 167 USPQ 676 (CCPA 1970). Applicant must show that commercial success alleged is not due to other factors such as promotion, advertising, ^{etc} ect.

The affidavits of Gregg Harrison and Graham Bell are given very little probative value for the following reasons:

(1) Mr. Harrison and Mr. Bell merely provide a statement alleging an increase in life of the present invention.

(2) The affidavits fail to demonstrate unexpected results or properties.

(3) The affidavits fail to compare the closest prior art relied upon and the claimed invention under identical conditions except for the novel features of the invention. In re Brown, 173 USPQ 685; In re Chapman, 148 USPQ 711.

Action Made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 703-308-1405. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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H Payer
July 10, 2002



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